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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/089,751

07/31/2002

Karl-Willie Hoel

48046/DBP/T164

2804

23720 7590 08/23/2007  
WILLIAMS, MORGAN & AMERSON  
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HOUSTON, TX 77042

EXAMINER
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BEACH, THOMAS A

ART UNIT	PAPER NUMBER
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3671

MAIL DATE	DELIVERY MODE
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08/23/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/089,751

**Applicant(s)**

HOEL, KARL-WILLIE

**Examiner**

Thomas A. Beach

**Art Unit**

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-54 and 64 is/are allowed.
- 6) ☒ Claim(s) 55-62 is/are rejected.
- 7) ☒ Claim(s) 63 and 65-67 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 55-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham et al. (US 5,819,852) alone. Regarding claim 65, Cunningham discloses a subsea device (Figs. 1 and 2) for attachment to a subsea Christmas tree (14, Fig. 2) comprising at least one tree passage (68, 70) therethrough, the device including:

- A pressure control device (76, 78, 80),
- A tool housing assembly (generally 52 and 54; column 3 lines 46-50) positioned above the pressure control device,
- A sealing assembly (58) positioned above the tool housing assembly which could be adapted to seal around a tool lowering means (claim 56-57),
- At least one lubricator passage (52, 60, 64, 68, 54, 62, 66, 70) which communicates with at least one tree passage in the subsea Christmas tree (Fig. 2); and at least one bypass assembly (82) comprising at least one bypass passage which communicates with at least one tree passage (68) in the subsea Christmas tree (14). The device of Cunningham differs from the claimed invention in that it is not explicitly stated to be a lubricator, however, the device discloses the features of the claimed invention and could

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perform the same operations. Therefore, it could effectively be considered a lubricator. Also, Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Cunningham to include either a grease injector or stuffing box since they are notoriously well known component in subsea production in order to complete implementation of production.

Regarding claims 61-62, Cunningham discloses the at least one bypass assembly (82) further comprising at least one lower bypass pipe (Fig.2, below 84), and at least one upper bypass pipe (Fig. 2, above 84) removably connected to the at least one lower bypass pipe (by disconnection of riser safety package 24).

#### ***Allowable Subject Matter***

3. Claims 24-54 and 64 allowed.
4. Claims 63 and 65-67 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

5. Applicant's arguments filed 07/26/07 have been fully considered but they are not persuasive. Applicant's arguments are noted; however, newly added claims 55-67 do not positively recite a lubricator unlike the allowed claims. Therefore, this issue amounts to intended use in the preamble and the rejection presented.

**Conclusion**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Beach whose telephone number is 571.272.6988. The examiner can normally be reached on Monday-Friday, 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Will can be reached on 571.272.6998. The fax phone number for the organization where this application or proceeding is assigned is 571.273.8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thomas A. Beach

August 20, 2007

**THOMAS A. BEACH**  
Primary Examiner  
Group 3600